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23550	7590	01/30/2004		
HOFFMAN WARNICK & D'ALESSANDRO, LLC 3 E-COMM SQUARE ALBANY, NY 12207			EXAMINER STEPHENS, JACQUELINE F	
			ART UNIT 3761	PAPER NUMBER 8
DATE MAILED: 01/30/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/871,717

Applicant(s)

VALENTIN ET AL.

Examiner

Jacqueline F Stephens

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3761

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-63 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-63 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6,7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-63 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-3, 12, and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Roe et al. USPN 5989236.

As to claim 1, Roe discloses an incontinence article **20** comprising a front portion **34**, a rear portion **38**, and a back guard **62** extending vertically from the rear portion to a middle back area of a user (Figures 1 and 6; col. 1, lines 43-45 and col. 9, lines 38-41).

As to claim 2, Roe discloses tabs 44 for coupling the front portion to the rear portion (Figure 1 and col. 6, lines 7-9).

As to claim 3, Roe discloses the back guard further comprises a flap **92** that may be made of any known material suitable for use in a disposable absorbent article, such as the same material as the topsheet (col. 4, lines 41-44 wood or cotton fibers and

rayon fibers, which are all absorbent materials). The flap 92 is centrally located centrally on the back guard (Figures 10 and 11).

As to claim 12, see Figure 11.

As to claim 13, see Figure 6.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 4-11, 14-21, 29, and 43-55 rejected under 35 U.S.C. 103(a) as being unpatentable over Roe et al. USPN 5989236.

As to claims 4-7, Roe discloses the back guard comprises elastics and the guard is elastically extensible in one or more directions. However, Roe is silent as to where the elastic is positioned. The back guard of Roe serves to elongate the diaper so it can fit a variety of users, and is elastically extensible for this purpose. It would have been an obvious matter of design choice to have the elastic materials on the entire back guard or on the periphery, since either structure would elongate the back guard so as to fit a variety of users and contain exudates, and since applicant has not disclosed limiting the elastic to the periphery solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with the elastic in other regions of the back guard.

As to claim 8, the side portions of the back guard are curved, Figure 9.

As to claim 9, the side portions of the back guard are linear, Figure 8.

As to claims 10, 11, 14, 20, and 21 Roe does not disclose the back guard has a length of approximately 1.0 – 10.0 inches. It is evident that Roe has a value for the length of the back guard. Roe recognizes the length of the back guard should be sufficient to adjust in length to fit a large range of wearer sizes and to provide an absorbent article, which can be fitted to a wearer in a high-back configuration (col. 1, lines 39-45). It would have been an obvious matter of design choice to provide the article of Roe with the claimed dimensions, since such a modification would have involved a mere change in the size of a component. A change in size is generally

recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Roe discloses an incontinence article **20** comprising a front portion **34**, a rear portion **38**, and a back guard **62** extending vertically from the rear portion to a middle back area of a user (Figures 1 and 6; col. 1, lines 43-45 and col. 9, lines 38-41). Roe further discloses the back guard further comprises a flap **92** that may be made of any known material suitable for use in a disposable absorbent article, such as the same material as the topsheet (col. 4, lines 41-44 wood or cotton fibers and rayon fibers, which are all absorbent materials). The flap **92** is centrally located centrally on the back guard (Figures 10 and 11).

The vertical extension of Roe is capable of extending to a middle back area of a user. For instance, is the elongated diaper of Roe is designed to adjust to the size of various users (col. 7, lines 55-62). Therefore, if the diaper is placed on a smaller infant, the diaper would extend to a middle back area of the infant as opposed to the same diaper being used on a toddler.

As to claims 15, 16, and 19, Roe discloses the back guard comprises elastics and the guard is elastically extensible in one or more directions. However, Roe is silent as to where the elastic is positioned. The back guard of Roe serves to elongate the diaper so it can fit a variety of users, and is elastically extensible for this purpose. It would have been an obvious matter of design choice to have the elastic materials on

the entire back guard or on the periphery, since either structure would elongate the back guard so as to fit a variety of users and contain exudates, and since applicant has not disclosed limiting the elastic to the periphery solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with the elastic in other regions of the back guard. Roe further discloses the back guard is curved (Figures 9 and 11).

As to claim 17, the side portions of the back guard are curved, Figure 9.

As to claim 18, the side portions of the back guard are linear, Figure 8.

As to claims 29, 43-47, and 50-53, Roe does not disclose the back guard has a length of approximately 1.0 – 10.0 inches. It is evident that Roe has a value for the length of the back guard. Roe recognizes the length of the back guard should be sufficient to adjust in length to fit a large range of wearer sizes and to provide an absorbent article, which can be fitted to a wearer in a high-back configuration (col. 1, lines 39-45). It would have been an obvious matter of design choice to provide the article of Roe with the claimed dimensions, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Roe discloses an incontinence article **20** comprising a front portion **34**, a rear portion **38**, a crotch portion **36**, and a back guard **62** extending vertically from the rear

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portion to a middle back area of a user (Figures 1 and 6; col. 1, lines 43-45 and col. 9, lines 38-41). The back guard comprises opposing horizontal extensions **44**. Roe further discloses the back guard further comprises a flap **92** that may be made of any known material suitable for use in a disposable absorbent article, such as the same material as the topsheet (col. 4, lines 41-44 wood or cotton fibers and rayon fibers, which are all absorbent materials). The flap **92** is centrally located centrally on the back guard (Figures 10 and 11).

Roe discloses the back guard comprises elastics and the guard is elastically extensible in one or more directions. However, Roe is silent as to where the elastic is positioned. The back guard of Roe serves to elongate the diaper so it can fit a variety of users, and is elastically extensible for this purpose. It would have been an obvious matter of design choice to have the elastic materials on the entire back guard or on the periphery, since either structure would elongate the back guard so as to fit a variety of users and contain exudates, and since applicant has not disclosed limiting the elastic to the periphery solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with the elastic in other regions of the back guard. Roe further discloses the back guard is curved (Figures 9 and 11).

As to claim 48, see Figure 11.

As to claim 49, Roe discloses tabs **44** for coupling the front portion to the rear portion (Figure 1 and col. 6, lines 7-9).

As to claim 54, the absorbent material is flap **92** is separately positioned from the elastic in guard **62** (Figure 10).

As to claim 55, Roe discloses the flap **92** can be integral with other elements, which includes guard **62**, therefore, the absorbent material is flap **92** is commonly positioned from the elastic in guard **62** (col. 8, lines 46-50).

7. Claims 22-24, 26, 28, 30-42, and 60-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allen et al. USPN 5106385 in view Roe.

As to claims 22, 23, 30-35, 37, 60, 62, and 63 Allen discloses an incontinence article **10** comprising: a front portion **19**, a rear portion **18** joined to the front portion, and a back guard **40** extending from above the rear portion (Figure 3A). The back guard extends above the front portion when the article is worn by a user (Figures 3B and 3C shows the extension panel increasing the size of the diaper. Allen discloses the back guard comprises a cloth or fabric, but is silent as to whether the back guard **40** comprises an absorbent material. Roe discloses an incontinence article having a back guard, which further comprises a flap **92** that may be made of any known material suitable for use in a disposable absorbent article, such as the same material as the topsheet (col. 4, lines 41-44 wood or cotton fibers and rayon fibers, which are all absorbent materials). The flap **92** is centrally located centrally on the back guard (Figures 10 and 11). It would have been obvious to one having ordinary skill in the art

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at the time the invention was made to modify the back guard of Allen to include an absorbent material as disclosed in Roe. Doing so would provide a back guard that is soft feeling and nonirritating to the wearer's skin (Roe col. 4, lines 37-39 and col. 8, lines 45-50).

Allen does not disclose the back guard **40** comprises elastic material. Roe discloses the back guard comprises elastics and the guard is elastically extensible in one or more directions for the benefit of providing improved fit (Roe col. 7, lines 55-60). It would have been obvious to provide the back guard of Allen with elastics for the benefits disclosed in Roe.

Allen/Roe is silent as to where the elastic is positioned. The back guard of Allen/Roe serves to elongate the diaper so it can fit a variety of users, and is elastically extensible for this purpose. It would have been an obvious matter of design choice to have the elastic materials on the entire back guard or on the periphery, since either structure would elongate the back guard so as to fit a variety of users and contain exudates, and since applicant has not disclosed limiting the elastic to the periphery solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with the elastic in other regions of the back guard. The back guard comprises a vertical extension and opposing horizontal extensions (Allen Figures 3A-3C).

As to claims 24 and 26, see Allen, Figures 3A-3C.

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As to claims 28, 41 and 42, Allen/Roe does not disclose the back guard has a length of approximately 1.0 – 10.0 inches. It is evident that Allen/Roe has a value for the length of the back guard. Allen/Roe recognizes the length of the back guard should be sufficient to adjust in length to fit a large range of wearer sizes and to provide an absorbent article, which can be fitted to a wearer in a high-back configuration (Allen col. 1, lines 40-49; Roe col. 1, lines 39-45). It would have been an obvious matter of design choice to provide the article of Allen/Roe with the claimed dimensions, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

As to claim 36, see Allen Figures 3A and 3B.

As to claims 38 and 39, see Allen Figure 3C.

As to claims 40 and 61, the vertical extension of Allen/Roe is capable of extending to a middle back area of a user. For instance, is the elongated diaper of Allen/Roe is designed to adjust to the size of various users (Allen col. 1, lines 40-49). Therefore, if the diaper is placed on a smaller infant, the diaper would extend to a middle back area of the infant as opposed to the same diaper being used on a toddler.

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8. Claims 25 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allen in view of Roe as applied to claim 22 above and further in view of Goyal USPN 6119275.

Allen/Roe discloses the present invention substantially as claimed. However, Allen/Roe does not disclosed the back guard **40** is curved. Goyal discloses a back guard **1** that is curved for the benefit of conforming to the shape of the wearer's back (Goyal col. 1, line 66 through col. 2, line 2). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the back guard of Allen/Roe to be curved for the benefits disclosed in Goyal.

9. Claims 56-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roe view of Glaug et al. USPN 6258076.

As to claims 56 and 57, Roe discloses the present invention substantially as claimed. However, Roe does not disclose a front guard extending vertically from the front portion to a middle chest area of a user. Glaug discloses a disposable absorbent article comprising a vertical extension (in use) barrier wall for that is present on the front and rear portions of the diaper (Figure 4, for the benefit of impeding the egress of the loose or liquid waste from the front waist portion of the disposable absorbent article (Glaug col. 4, lines 7-11). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the diaper of Roe to have a vertically extending front guard for the benefits disclosed in Glaug.

Roe/Glaug discloses an incontinence article **20** comprising a front portion **34**, a rear portion **38**, and a back guard **62** extending vertically from the rear portion to a middle back area of a user (Roe Figures 1 and 6; col. 1, lines 43-45 and col. 9, lines 38-41). Roe further discloses the back guard further comprises a flap **92** that may be made of any known material suitable for use in a disposable absorbent article, such as the same material as the topsheet (Roe col. 4, lines 41-44 wood or cotton fibers and rayon fibers, which are all absorbent materials). The flap **92** is centrally located centrally on the back guard (Roe Figures 10 and 11).

The vertical extension of Roe is capable of extending to a middle back area of a user. For instance, is the elongated diaper of Roe is designed to adjust to the size of various users (Roe col. 7, lines 55-62). Therefore, if the diaper is placed on a smaller infant, the diaper would extend to a middle back area of the infant as opposed to the same diaper being used on a toddler.

As to claim 58, Roe/Glaug discloses the back guard comprises elastics and the guard is elastically extensible in one or more directions. However, Roe/Glaug is silent as to where the elastic is positioned. The back guard of Roe/Glaug serves to elongate the diaper so it can fit a variety of users, and is elastically extensible for this purpose. It would have been an obvious matter of design choice to have the elastic materials on the entire back guard or on the periphery, since either structure would elongate the back guard so as to fit a variety of users and contain exudates, and since applicant has not disclosed limiting the elastic to the periphery solves any stated problem or is for any

particular purpose and it appears that the invention would perform equally well with the elastic in other regions of the back guard.

As to claim 59, Roe/Glaug does not disclose the back guard has a length of approximately 1.0 – 10.0 inches. It is evident that Roe has a value for the length of the back guard. Roe recognizes the length of the back guard should be sufficient to adjust in length to fit a large range of wearer sizes and to provide an absorbent article, which can be fitted to a wearer in a high-back configuration (Roe col. 1, lines 39-45). It would have been an obvious matter of design choice to provide the article of Roe with the claimed dimensions, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacqueline F Stephens whose telephone number is (703) 308-8320. The examiner can normally be reached on Monday-Friday 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Calvert can be reached on (703)305-1025. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

Jacqueline F Stephens
Examiner
Art Unit 3761




GLENN K. DAWSON
PRIMARY EXAMINER

January 24, 2004